

### REMARKS

Claims 1-55 were examined. Claims 1-22 were allowed, and claims 23-55 were rejected. More specifically, claims 28-31 were rejected as introducing new matter not adequately supported by the subject patent. Claims 47 and 52 were rejected for indefiniteness. Claims 23-27, 32-47, and 51-55 were rejected as being anticipated by Yoshimura USP 5,560,796. Finally, claims 26-31 and 36-55 were rejected as being anticipated by Hill USP 4,673,609. Further the Reissue Declaration was objected to.

Applicant submits herewith a Supplemental Re-issue Declaration of Gregory E. Ross, in which paragraph 10 now includes language addressing the Examiner's contentions.

Applicant has amended amend claims 32, 38, 47, and 52, and has added new claims 56-63. Claims 1-63 are pending, wherein claims 1-22 stand allowed.

#### A. CLAIMS 28-31 DO NOT PRESENT NEW MATTER:

At ¶3 and ¶4 of the Office Action, the Examiner questioned adequacy of support for the method step of applying a light absorbing coating over at least a portion of the second side of the base. Referring to col. 7, line 33 of applicant's USP 5,830,529, the language "substantially black partial coating" refers to a coating that is indeed a light absorbing coating. For Example, *The Random House Dictionary of the English Language* (College Ed.) defines "black" as:

lacking hue and brightness; absorbing light without reflecting  
any of the rays comprising it . . .

Applicant's use of the adjective "black" in describing a coating at col. 7, line 33 is understood by those skilled in the art to refer to a coating that absorbs light. To the extent the Examiner feels clarification is needed with respect to the "second side of the base" language, support for this language may be found at col. 15, lines 22-24, at col. 24, lines 36-39, and at col. 50, lines 39-41 in USP 5,830,529. Thus, applicant submits claim 28 is supported by USP 5,830,529. Since claims 29-31 depend from claim 28, they too are supported by USP 5,830,529. Thus the rejection to claims 28-31 under 35 USC §112, ¶1 must be withdrawn.

**B. AMENDED CLAIMS 47 AND 52 ARE NOT INDEFINITE:**

At ¶7 of the Office Action the Examiner questioned whether claims 47 and 52 were sufficiently definite to satisfy 35 USC §112, ¶2. Objected-to original claim 47 attempted to state that applicant's base may have various shapes and configurations including various planar and curved shapes, compound curves, etc., for example as depicted in Figs. 3A, 4A, 4B, 13A, 13B, etc. and as described three-dimensionally at col. 24, lines 16-29. Amended claim 47 is supported by these (and other figures) and overcomes the indefiniteness rejection.

Amended claim 52 recites that at least a surface portion of the coating of claim 51 defines a second base. Support for use of a coating surface as a base may be found in USP 5,830,529 at col. 18, lines 49-50.

**C. CLAIMS 23-27, 32-47, AND 51-57 ARE NOT ANTICIPATED BY YOSHIMURA**

Claim 23(c) and (d) require applying at least a second coating over at least a portion of a first coating, and forming an edge that defines a perimeter for both coatings to achieve at least substantial registration between the two coatings.

Yoshimura, on the other hand, first prints a desired print pattern onto material and then punches to make regions of the post-punched material conform to the desired print pattern. Ignoring for the moment shear-type damage adjacent punched edges, Yoshimura's material cannot fairly be said to be in substantial registration except perhaps at the edge of a punched region. Thus, non-punched regions of Yoshimura's material will not necessarily be formed in substantial registration, unlike applicant's invention. Thus, Yoshimura fails to disclose every step recited in claim 23, and is not a proper §102(e) reference. Claims 24, 25, 26 and 27 depend from claim 23 and are similarly not anticipated by Yoshimura.

Amended claim 32 clarifies that a base is formed at step (a), then an edge is formed at step (b), and that application of the first coating at step (c) is carried out after edge formation in step (b). Note applicant's definition of "edge" in USP 5,830,529 at col. 5. But at best Yoshimura applies a coating and then forms an edge. As such, Yoshimura

does not disclose the sequence of steps found in amended claim 32, and should not remain as a §102(e) reference against claim 32, or against claims 33-35, which depend from claim 32.

Claim 36 is directed to a structure that includes a second coating having at least one edge that defines at least one base perimeter, and wherein the second coating and a first coating are aligned with each other on at least a part of the edge.

But Yoshimura does not disclose a structure having a second coating that forms a perimeter. Thus, Yoshimura is not a valid §102 reference against claim 36, or claims 37-49, which depend therefrom.

Claim 51 is directed to a structure that comprises at least two bases attached to each other, at least one coating, and at least one edge defining a perimeter. But Yoshimura does not disclose a structure having at least two such bases. Thus applicant submits Yoshimura is not a proper §102 reference against claim 51, or against claims 52-55, which depend from claim 51.

**D. CLAIMS 28-31 AND 36-55 ARE NOT ANTICIPATED BY HILL**

Claim 28 is directed to forming a laminate pattern of coatings such that “substantial registration” is attained between successive coatings along at least one defined edge in a laminate pattern of such coatings. Hill, on the other hand, attains what he defines as “exact registration” by virtue of his mechanical punching, drilling, etc. Applicant submits that Hill does not disclose every step found in amended claim 28, and that Hill is overcome as a §102 reference as to claim 28, and also as to claims 29-31, which depend from claim 28.

Claim 36 requires in part a “second coating having at least one edge that defines at least one perimeter of said base”. Thus, the invention defined by claim 36 has at least two coatings that are aligned on an edge, where one of the coatings is on the perimeter of the base. But Hill does not disclose use of a second coating to define a perimeter.

Hill seeks registration by removing a portion of an image, or by drilling, etc. such that layers of image design may be applied over the silhouette patterns.

As such, Hill does not disclose every element recited in claim 36, and is not a proper §102 reference. Claims 37-50 depend from claim 36, and also are not anticipated by Hill.

Claim 51 includes first and second bases that are attached, and whose edges are not necessarily required to be aligned with each other, e.g., as shown in Figs. 1A and 1B, 3A, etc. Hill does not disclose applicant's first and second bases. Thus, applicant submits Hill is overcome as a §102 reference. Claims 52-55 depend from claim 51 and are similarly not anticipated by Hill.

#### E. NEW CLAIMS 57-61 ARE SUPPORTED

Claim 57 is supported by Figs. 41A, 41B, and 42D in USP 5,830,529, which figures show a cross section through a base with defined edges in which at least one coating is aligned with an edge. The edge defines the perimeter of a light passage. This is apparent from the optical paths of a viewer 89A and 89B seeing through the light passages in one or two directions, as well as where the observer sees indicia in one direction and the other side of the construction through the light passage. Note in Fig. 41A that observer 89A looks through the light passage formed by the edge on the left hand side of see-through surface 6 to view indicia 77B on a second material attached to the right hand side of see-through surface 6.

Claim 58 is supported by USP 5,830,529 at col. 37, lines 45-51 and at Fig. 37G, directed to a base 1 comprising a plurality of light passages 28, formed by the edges 2, applied by direction of movement 66 to a surface 17 of a see-through material 6. Also, see col. 62, lines 32-45.

Claim 59 section (i) is supported by USP 5,830,529 at col. 62, lines 35-40. Claim 59(ii) is supported by col. 1, lines 42-55 (particularly from line 46), with use of magnetic force

disclosed at line 50. See also col. 1, line 55, and lines 60-61, whereas "magnetic attraction" is disclosed. Claim 59(iii) is supported in USP 5,830,529 by col. 29, lines 54-61 regarding static cling, as well as in Fig. 41A, where base 6B is temporarily attached (static cling) to see-through material 6. Such temporary attachment is also shown in sides of Fig. 41B. Claim 59(iv) is supported by col. 9, lines 23-35 and line 24 with respect to "heat", while claim 59(v) is supported by col. 9, line 25 as to "pressure".

Claims 60-63 are supported by original claim 28.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made."

#### CONCLUSION

The indefiniteness and anticipation rejections raised in the Office Action are overcome by this Amendment. Claims 1-22 stand allowed. Claims 23-63 should also be allowed at this juncture.

The Commissioner is authorized to charge any additional fees that may be required, including extension fees, or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. RI-69912/MAK).

Respectfully submitted,

FLEHR HOHBACH TEST  
ALBRITTON & HERBERT LLP

By: Michael A. Kaufman  
Michael A. KAUFMAN  
Reg. No. 32,998  
Attorneys for Applicant

Four Embarcadero Center - Suite 3400  
San Francisco, California 94111-4187  
Tel.: (415) 781-1989  
Fax: (415) 398-3249

## VERSION WITH MARKINGS TO SHOW CHANGES MADE

### IN THE CLAIMS:

Claims 32, 38, 47 and 52 have been amended as follows:

32. (Amended) A method of forming a pattern of coatings onto a panel with substantial registration between at least a part of successive coatings along at least one edge of the pattern, the method comprising the steps of:

- a) providing a base;
- b) forming an edge to define a perimeter for said coatings to achieve substantial registration;
- c) after forming said edge, applying a first coating to at least a part of said base; and
- d) applying at least one additional coating over at least a portion of said first coating.

38. (Amended) An article of manufacture according to claim 36, wherein said at least a part of said base is attachably mountable on an object selected from a group consisting of (i) a vehicle, (ii) a building, (iii) a container, (iv) cookware, (v) an adhesively attachable light permeable material, (vi) a second base, (vii) a second base[e] having indicia such that illumination permits viewing of said indicia.

47. (Amended) An article of manufacture, according to claim 36, wherein said base has at least one characteristic selected from a group consisting of (i) at least a portion of said base is planar, [substantially three-dimensional, and] (ii) at least a portion of said base has a uniform thickness, and one surface of said base is a surface at a different base level on a different surface portion of said base ~~(iii) and at least a portion of said base is non-planar.~~

52. (Amended) An article of manufacture, according to claim 51, wherein at least a surface portion of said ~~one said~~ coating ~~comprises~~ defines a second base.

New claims 56-63 have been added as follows:

56. The method of claim 23, wherein step (b) further includes applying at least one coating to at least a portion of a surface of said base opposite a side of said base to which said first coating was applied.

57. The method of claim 23, wherein step (d) includes forming a plurality of edges that define at least one light passage.

58. The method of Claim 57, further including disposing said base proximate a see-through surface.

59. The method of claim 58, wherein said disposing has at least one characteristic selected from a group consisting of (i) said disposing uses adhesive, (ii) said disposing uses magnetic attraction, (iii) said disposing uses static cling, (iv) said disposing uses heat, and (v) said disposing uses pressure.

60. A method of forming a laminate pattern of coatings onto a material with substantial registration between successive coatings along at least one defined edge, the method comprising the steps of:

a) providing a base;

b) modifying said base on at least one base surface to define at least one edge;

c) applying a first coating to said one surface of said base so as to use said edge to define at least one perimeter of said first coating;

d) applying a second coating adjacent said first coating so as to use said edge to define at least one perimeter of said second coating; and

(e) applying a third coating on a second surface of said base.

61. The method of claim 60, wherein step (d) includes applying said second coating on said first coating.

62. The method of claim 60, wherein step (d) includes applying said second coating in close proximity to said first coating.

63. The method of claim 60, wherein step (b) is carried out after step (e).